

### REMARKS

Claims 1-5, 8, and 24-29 are currently pending. Claims 4, 6-7, and 9-23 have been canceled. Claims 1 and 26 are hereby amended to clearly recite that the entire inner shaft is adapted to fit within the internal bore of the outer shaft so that the inner shaft and the outer shaft are slidably engaged. Support for these amendments can be found in paragraph twelve of the specification as filed.

The Examiner has rejected claims 1-3, 5, and 8 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,860,946 issued to Hofstatter. The Examiner argues that Hofstatter discloses a bone or cartilage implant delivery device comprising, e.g. 1, having a proximal and a distal end, a longitudinal axis, and an internal bore along the longitudinal axis of the outer shaft, wherein the distal end of the outer shaft is suitable for holding an implant at 3, and an inner shaft, e.g. 2, having a distal end and a proximal end, wherein the proximal end of the inner shaft is suitable for insertion into a defect, the inner shaft adapted to fit within the internal bore of the outer shaft so that the inner shaft and the outer shaft are slidably engaged.

As stated above, claim 1 has been amended to clearly recite that the entire inner shaft is adapted to fit within the internal bore of the outer shaft. Hofstatter does not disclose a delivery device having an inner shaft and an outer shaft wherein the entire inner shaft is adapted to fit within an internal bore of the outer shaft. Therefore, Hofstatter does not anticipate amended claim 1 and, since claims 2-3, 5, and 8 depend either directly or indirectly from amended claim 1, claims 2-3, 5, and 8 are not anticipated by Hofstatter either. It is respectfully requested that claims 1-3, 5, and 8 be allowed.

The Examiner has rejected claims 24-28 under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,782,835 issued to Hart et al. The Examiner argues that Hart discloses the method of Applicant's independent claim 24. Applicants respectfully disagree with the Examiner's argument. Specifically, Hart does not disclose the following elements of independent claim 24:

inserting the proximal end of the inner shaft into the defect until the proximal end of the inner shaft contacts the bottom of the defect;

advancing the outer shaft in the proximal direction until the proximal end of the outer shaft contacts the surface of tissue surrounding the defect, causing a portion of the implant to extend beyond the distal end of the outer shaft;

cutting off the portion of the implant extending beyond the distal end of the outer shaft, leaving a remaining portion disposed within the outer shaft;

Therefore, independent claim 24 is not anticipated by Hart, and since claim 25 depends from claim 24, claim 25 is not anticipated by Hart either. It is respectfully requested that claim 24 and claim 25 be allowed. In addition, the Examiner argues that Hart anticipates independent claim 26. As stated above, independent claim 26 has been amended to clearly recite that the entire inner shaft is adapted to fit within the internal bore of the outer shaft. Hart does not disclose a kit that includes a delivery device having an inner shaft and an outer shaft wherein the entire inner shaft is adapted to fit within an internal bore of the outer shaft. Therefore, Hart does not anticipate amended independent claim 26 and, since claims 27 and 28 depend from amended claim 26, claims 27 and 28 are not anticipated by Hart either. It is respectfully requested that claims 26-28 be allowed.

The Examiner has rejected claim 29 under 35 U.S.C. 103(a) as being unpatentable over Hart et al. in view of US Patent No. 5,697,932 issued to Smith et al. Claim 29 depends from independent claim 26. As stated above, independent claim 26 has been amended to clearly recite that the entire inner shaft is adapted to fit within the internal bore of the outer shaft. Hart does not disclose a kit that includes a delivery device having an inner shaft and an outer shaft wherein the entire inner shaft is adapted to fit within an internal bore of the outer shaft. Therefore, Hart does not anticipate amended independent claim 26 and, since claim 29 depends from amended claim 26, claim 29 is not anticipated by Hart either. Furthermore, Smith et al does not overcome these deficiencies in Hart. Therefore, it is respectfully submitted that claim 29 is patentable over Hart in view of Smith.

Applicants do not acquiesce to the characterizations of the art. For brevity and to advance prosecution, however, Applicants may have not addressed all characterizations of the art, but reserve the right to do so in further prosecution of this or a subsequent application.

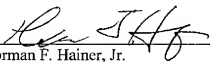
The absence of an explicit response by the applicant to any of the examiner's positions does not constitute a concession of the examiner's positions. The fact that applicant's comments have focused on particular arguments does not constitute a concession that there are not other good arguments for patentability of the claims. All of the dependent claims are patentable for at least the reasons given with respect to the claims on which they depend.

Please apply any charges or credits to Deposit Account No. 192563.

Respectfully submitted,

Date: \_\_\_\_\_

5/11/07

  
\_\_\_\_\_  
Norman F. Hainer, Jr.  
Reg. No. 55,239

Smith & Nephew, Inc.  
150 Minuteman Road  
Andover, MA 01810  
Telephone: 978-749-1311  
Facsimile: 978-684-6417